

NAKAJIMA -- 09/630,563
Client/Matter: 007874-0271791

REMARKS

Claims 1-35 are pending. By this Amendment, claims 1, 3, 20, 27-29 are amended and claims 30-35 are added. Reconsideration in view of the above amendments and following remarks is respectfully requested.

MPEP §706.07(a) states: "Under present practice, second or subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information as submitted in an Information Disclosure Statement filed during the period set forth in 37 C.F.R. 1.97(c) with the fees set forth in 37 C.F.R. 1.17(p)."

The September 2, 2003 Office Action rejected claims 1-11, 15, 17, 18 and 20-29 under 35 U.S.C. §103(a) over Mobile Commerce in view of Official Notice, Dunlap, PR Newswire and Gifford (U.S. Patent 5,724,424). Dependent claims 12-14 were rejected under 35 U.S.C. §103(a) over the aforementioned references and further in view of Steinberg. Dependent claims 16 and 19 were rejected under 35 U.S.C. §103(a) over the aforementioned references and further in view of Meyers.

In the response filed February 2, 2004, Applicant did not amend any of original claims 1-29.

The May 3, 2004 Office Action rejects claims 1-11, 15, 17-18 and 20-29 under 35 U.S.C. §103(a) over Mobile Commerce in view of PR Newswire. Claims 12-14 were rejected under 35 U.S.C. §103(a) over Mobile Commerce in view of PR Newswire and further in view of Steinberg. Claims 16 and 19 were rejected under 35 U.S.C. §103(a) over Mobile Commerce in view of PR Newswire and further in view of Meyers.

The May 3, 2004 Office Action states on page 2 that the reliance on "Official Notice and Dunlap were withdrawn as being redundant." The Office Action also states that "Gifford was removed from the claimed rejections as being redundant, given that PR Newswire, by virtue of identifying US 5,724,424 (Gifford), is sufficient to reference Gifford in the body of the Office Action." The May 3, 2004 Office Action was made a final rejection.

The finality of the May 3, 2004 Office Action is premature and must be withdrawn. As discussed above, no amendments were made to original claims 1-29 in the February 2, 2004 response by Applicant. Accordingly, the change in the grounds of rejection was not necessitated by Applicant's amendment nor based on information submitted in an

NAKAJIMA - 09/630,563
Client/Matter: 007874-0271791

Information Disclosure Statement filed under Rule 97(c). Therefore, the finality of the May 3, 2004 Office Action is premature, improper, and must be withdrawn.

Applicant additionally submits that the Examiner's withdrawal of the use of Official Notice, Dunlap and Gifford as being "redundant" is improper and incorrect. If it is now the Examiner's position that all of the features of the claimed invention previously allegedly disclosed by the taking of Official Notice, Dunlap and Gifford are now somehow disclosed or suggested by Mobile Commerce and/or PR Newswire, the Examiner is respectfully requested to point out where in Mobile Commerce and/or PR Newswire these features are allegedly disclosed or suggested. In addition, Applicant respectfully submits that the Examiner's conclusion that PR Newswire's identification of US Patent 5,724,424 to Gifford "is sufficient to reference in the body of the Office Action" is also incorrect and improper. The Examiner relied on Gifford in the September 2, 2003 Office Action to teach a plurality of features discussed on page 8, lines 2-11 of the September 2, 2003 Office Action. Is it now the Examiner's position that all of these features allegedly disclosed by Gifford and discussed in the September 2, 2003 Office Action, and relied upon in rejecting the claims, are somewhere disclosed in the PR Newswire article simply because the PR Newswire article mentions that US Patent 5,724,424 was granted to Open Market, Inc.? The PR Newswire article simply discloses that US Patent 5,724,424 covers secure, real time payment using credit and debit cards over the internet and is one of the earliest and broadest internet payment patents granted. Is it now the Examiner's position that this mere discussion of Gifford in the PR Newswire article discloses everything discussed on page 8, lines 2-11 of the September 2, 2003 Office Action? If so, the Examiner is respectfully requested to point out with particularity where all of the features allegedly previously shown by Gifford and discussed on page 8, lines 2-11 of the September 2, 2003 Office Action are found in either Mobile Commerce or PR Newswire.

As the finality of the May 3, 2004 Office Action is premature and improper and must be withdrawn, Applicant is entitled to entry of this amendment. See MPEP §706.07(e).

Reconsideration and withdrawal of the finality of the May 3, 2004 Office Action and entry of this amendment are respectfully requested.

Claims 1-11, 15, 17-18 and 20-29 were rejected under 35 U.S.C. §103(a) over Mobile Commerce in view of PR Newswire. The rejection is respectfully traversed.

Claims 1 recites an electronic settlement system to settle a transaction using a telecommunication network including, *inter alia*, a billing terminal for performing billing of

NAKAJIMA -- 09/630,563
Client/Matter: 007874-0271791

the transaction, a paying terminal for performing paying of the transaction, the paying terminal allowing a user to input information, a settlement apparatus for registering the paying terminal and performing the settlement of the transaction taking place between the billing terminal and the paying terminal via the telecommunication network, the settlement apparatus providing a transaction identifying number relating to the transaction with the billing terminal and presenting the transaction identifying number by the telecommunication network. The settlement apparatus synchronizes a communication to the billing terminal where the communication to the paying terminal when receiving the transaction identifying number as a user input information from the register paying terminal.

Neither Mobile Commerce nor PR Newswire, either alone or in combination, disclose at least a settlement apparatus for registering a paying terminal and performing the settlement of a transaction taking place between a billing terminal and the paying terminal via a telecommunication network, the settlement apparatus providing a transaction identifying number related to the transaction with the billing terminal and presenting the transaction identifying number by the telecommunication network, wherein the settlement apparatus synchronizes a communication to the billing terminal with a communication to the paying terminal when receiving a transaction identifying number as a user input information from the registered paying terminal. Accordingly, the combination of Mobile Commerce and PR Newswire does not disclose or suggest all the limitations of claim 1 and fails to present a *prima facie* case of obviousness against claim 1.

Claim 3 recites a settlement apparatus including a processing unit that, *inter alia*, synchronizes a communication to a billing terminal with a communication to a paying terminal when the processing unit sets a transaction identifying number to identify the transaction and when the paying terminal transmits to the settlement apparatus a transaction identifying number as a user input information which is the same as the transaction identifying number. Neither Mobile Commerce nor PR Newswire discloses or suggests this feature and the combination fails to present a *prima facie* case of obviousness against claim 3.

Claims 2-19 recite additional features of the invention and are allowable for the same reasons discussed above with respect to claim 1 and for the additional features recited therein. In addition, it is respectfully submitted that the additional references, including the second PR Newswire article, Steinberg and Meyers fail to cure the deficiencies of Mobile Commerce and PR Newswire with respect to claim 1, and that even assuming such combination would have been obvious, would not have resulted in the invention of claim 1.

NAKAJIMA -- 09/630,563
Client/Matter: 007874-0271791

Reconsideration and withdrawal of the rejection of claims 1-19 are respectfully requested.

Claim 20 recites a billing terminal, communicating with a settlement apparatus which performs a settlement of transaction, for performing billing of the transaction with a paying terminal which performs paying of the transaction. The paying terminal allows a user to input information. The billing terminal includes a communication unit which connects to the settlement apparatus via a telecommunication network. The communication unit transmits an identifying number to identify the billing terminal to the settlement apparatus and the communication unit receives a synchronization confirmation signal indicating an establishment of a synchronization with the paying terminal from the settlement apparatus when the settlement apparatus receives the identifying number as a user input information. A processing unit performs billing processing of the transaction.

Neither Mobile Commerce nor the PR Newswire disclose or suggest a billing terminal communicating with a settlement apparatus and including a communication unit which connects to the settlement apparatus via a telecommunication network, a communication unit transmitting an identifying number to identify the billing terminal to settlement apparatus and receiving a synchronization confirmation signal indicating an establishment of synchronization with the paying terminal from the settlement apparatus when the settlement apparatus receives the identifying number as a user input information. Accordingly, the combination of Mobile Commerce and PR Newswire fails to include all the limitations of claim 20 and fails to present a *prima facie* case of obviousness against claim 20.

Claims 21-26 recite additional features of the invention and are allowable for the same reasons discussed above with respect to claim 20 and for the additional features recited therein.

Reconsideration and withdrawal of the rejection of claims 20-26 are respectfully requested.

Claim 27 recites a recording medium that stores a program for a computer, communicating to a billing terminal performing billing of a transaction with a paying terminal performing paying of the transaction. The paying terminal allows a user to input information. The program includes a processing module that sets a transaction identifying number which identifies the transaction and synchronizes a communication to the billing terminal with a communication to the paying terminal when the paying terminal transmits a

NAKAJIMA -- 09/630,563
Client/Matter: 007874-0271791

transaction identifying number as a user input information which is the same as the transaction identifying number to the settlement apparatus.

There is no disclosure or suggestion by either Mobile Commerce or PR Newswire of setting a transaction identifying number which identifies a transaction and synchronizes a communication to a billing terminal with a communication to a paying terminal when the paying terminal transmits a transaction identifying number as a user input information which is the same as the transaction identifying number to the settlement apparatus. Accordingly, the combination of Mobile Commerce and PR Newswire fails to include all the limitations of claim 27 and fails to present a *prima facie* case of obviousness.

Reconsideration and withdrawal of the rejection of claim 27 are respectfully requested.

Claim 28 recites a method of settlement using a settlement apparatus which performs the settlement of a transaction while communicating to a billing terminal. The paying terminal allows a user to input information. The method includes, *inter alia*, synchronizing a communication to the billing terminal where the communication to the paying terminal when the paying terminal confirms the information about the billing terminal and transmits a transaction identifying number as a user input information to the settlement apparatus.

There is no disclosure or suggestion by either Mobile Commerce or PR Newswire of synchronizing a communication to a billing terminal with a communication to a paying terminal when the paying terminal confirms the information about the billing terminal and transmits the transaction identifying number as a user input information to a settlement apparatus, as recited in claim 28. Accordingly, the combination fails to include all the limitations of claim 28 and fails to present a *prima facie* case of obviousness against claim 28.

Reconsideration and withdrawal of the rejection of claim 28 are respectfully requested.

Claim 29 recites a settlement method using a settlement apparatus performing a settlement of a transaction for communicating to a billing terminal performing billing of the transaction with a paying terminal performing paying of the transaction. The paying terminal allows a user to input information. The method includes, *inter alia*, synchronizing a communication to the billing terminal with a communication to the paying terminal, when the paying terminal confirms the information about the billing terminal and transmits the transaction identifying number as a user input information to the settlement apparatus.

NAKAJIMA -- 09/630,563
Client/Matter: 007874-0271791

There is no disclosure or suggestions by either Mobile Commerce or PR Newswire of synchronizing a communication to a billing terminal with a communication to a paying terminal, when the paying terminal confirms the information about the billing terminal and transmits the transaction identifying number as a user input information to the settlement apparatus. Therefore, the combination fails to include all the limitations in claim 29 and fails to present a *prima facie* case of obviousness.

Reconsideration and withdrawal of the rejection of claim 29 are respectfully requested.

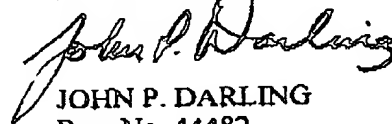
New claims 30-35 recite additional features of the invention and are allowable for the same reasons discussed above with respect to claims 1-29 and for the additional features recited therein. For example, claim 30 recites that the settlement apparatus synchronizes a communication to the billing terminal with a communication to the paying terminal when receiving a user ID from the registered paying terminal. As another example, claim 31 recites a settlement apparatus wherein a processing unit sets a transaction identifying number to identify the transaction and synchronizes a communication to a billing terminal with a communication to a paying terminal when the paying terminal transmits to the settlement apparatus a user ID as a transaction identifying number which is the same as the transaction identifying number. None of the applied prior art, either from the September 2, 2003 or the May 3, 2004 Office Action, disclose or suggest these features, either alone or combination.

In view of the above amendments and remarks, Applicant respectfully submits that all the claims are allowable and that the entire application is in condition for allowance.

Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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